IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
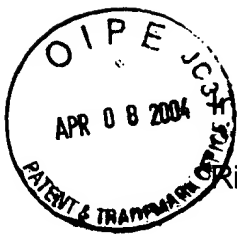
re Application of

Richard Bryan Sagar

Serial No.: 09/464,866

Filed: December 16, 1999
    Atty Docket No.: PHA-23.884

For: SHARED ADDRESS-DATA SERVICE
FOR PERSONAL CE-EQUIPMENT

Mail Stop – Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Attn: Examiner Stephen M. D'Agosta

Date: April 5, 2004

Examiner: Stephen M. D'Agosta

Art Unit: 2683

RECEIVED

APR 1 2 2004

Technology Center 2600

BRIEF BEFORE THE BOARD OF APPEALS

This is an appeal from a Final Rejection dated January 8, 2004. A Notice of
Appeal was received by the Patent Office on February 5, 2004.

REAL PARTY IN INTEREST

The real party in interest is Philips Electronics North America Corp.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 2-7 and 9-17 remain in the application and are presented in attached Appendix A.

No claims are allowed.

Claims 2-3, 6-7, and 9-17 stand as finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer (US 5,870,759) in view of Brunson (US 5,647,002) or Alley et al. (US 5,845,282).

Claims 4-5 stand as finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer/Brunson or Alley further in view of Nishino (US 6,233,452).

STATUS OF AMENDMENTS

Amendments to claims 1, 2, 8, and 10 were made in Applicant's Response to the Office Action Dated June 5, 2002. Amendments to claims 1, 8, and 11 were made in Applicant's Response to the Office Action Dated November 26, 2002. Amendments to claims 1, 8, and 11 were made in Applicant's Response to the Office Action Dated January 27, 2003. Claims 1 and 8 were cancelled, new claims 16 and 17 were added, and amendments were made to claims 2-7 and 9-11 in Applicant's Response to the Office Action Dated September 24, 2003. (The claims in the Appendix contain the amendments.) An amendment is submitted herewith to correct a lack of antecedent basis in claims 2 and 10, and to correct the dependency of claim 15.

The rejections of the claims, for reasons explained below, are clearly erroneous.

SUMMARY OF INVENTION

The present invention is generally directed to methods and systems for data transfer from one device to one or more other corresponding devices for a particular user so that the data is usable across the devices by an intermediate server's manipulation of the data. The devices are remote from the server.

ISSUES

1. Whether claims 2-3, 6-7, and 9-17 would be unpatentable over Bauer (US 5,870,759) in view of Brunson (US 5,647,002) or Alley et al. (US 5,845,282)?

2. Whether claims 4-5 would be unpatentable over Bauer/Brunson or Alley further in view of Nishino (US 6,233,452)?

GROUPING OF CLAIMS

Claims 2-7 and 9-17 stand and fall together except as otherwise indicated below.

ARGUMENT

Claim Rejections Under 35 USC § 103

Claims 2-3 and 6-7, and 16-17 are rejected under 35 USC 103(a) as being unpatentable over Bauer (US Pat. 5,870,759) in view of Brunson (US Pat. 5,647,002) or Alley et al. (US Pat. 5,845,282).

The Bauer reference is the primary reference for the rejections. Bauer is directed to management of a common database shared by a plurality of users in an

organization's production system. (Col. 1, Ins 9-17.) To facilitate data sharing, Bauer replicates a server-based database at a plurality of client nodes. (See, e.g., Col. 6, Ins 16-24.) The client systems therefore use the same data, albeit not necessarily in the same program applications.

Claims 16-17

Claims 16 and 17 are the base claims for claims 2-3 and 6-7 and will be discussed first. These claims clearly distinguish over the Bauer system, alone or in combination with the other cited references. For example, the claims recite selective transfer of data based on the server determining a particular set of corresponding apparatuses for a particular user from a plurality of sets for a plurality of users. To illustrate an embodiment within the scope of the claim:

> As an example, the invention provides an Internet service that allows the contents of **a person's PDA's contact database** to be uploaded to a server on the Internet. The server processes the data in order to extract phone numbers from the database. The Phone number data is transmitted, via wireless cellular phone network, to a **mobile phone, e.g., of that same person.**

(p. 4, Ins 25-28, emphasis added.)

In rejecting the claims, the Examiner has not identified in the prior art any teaching or suggestion that "each set of corresponding apparatuses being for a specific one of a plurality of users of the sets" and that for any one such user the remote intermediate server is manipulating and transferring data from one of the user's apparatuses to another, as claimed.

The Examiner cites to lengthy flow charts of Figs. 5a-b and 6a-b as showing "each set of apparatuses being for a specific one of a plurality of users of the sets" but does not point out where such limitations are found in the flow charts. Appellant therefore challenges the rejection of claims 16 and 17, and the dependent claims thereto, as not fully and clearly identifying where all claim limitations are found in the cited reference. See MPEP § 707.07(d) ("[w]here a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated.") Appellant is left to speculate how the cited passages disclose each element or limitation of the claims. After carefully reviewing the cited flowcharts and the associated text, Appellant submits that they are devoid of any teaching or suggestion that the two or more corresponding devices of a single user may be updated via an intermediate server--the teachings of Bauer are limited to only a single client-system per user. Therefore, the rejections are clearly erroneous for at least this reason.

Further, the system of Bauer is intended for sharing data across multiple nodes, each representing a different user. (Cols 1-2.) The complexity of sharing data in this manner would only be compounded by adding in multiple devices per client. For example, not only would conflicts need to be resolved at the user-server level, but also at the user-device to user-device level. While Bauer does describe receiving data from a client and transferring data to another client, it cannot be concluded that any other clients in the system represent devices for

the same user. Therefore, there is nothing inherent in Bauer or obvious from it that would render claims 16-17 and the dependent claims thereto unpatentable. *See Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) ("[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.")

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Similarly, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti,* 270 F.2d 810, 123 USPQ 349 (CCPA) 1959. In the present case, the proposed modification would render Bauer unsuitable for its intended purpose and would modify its principle of operation.

As an additional ground for reversal of the rejections, the combination is based on impermissible hindsight reconstruction of the invention. The Examiner considers Brunson or Alley to teach synchronization between different systems. The proposed modification of Bauer would not be desirable. Bauer is a server-centric database system intended to replicate the same data format to all clients

in an organization's production system. The proposed modification would complicate the system and defeat Bauer's stated objective:

> A goal of the database synchronizer is to minimize the cost of synchronization by reducing communication costs and delays in synchronizing the database data.

(Col. 1, lns 56-59.)

Accordingly, there would be no reason to complicate the system by configuring different client nodes with different data format requirements or by adding data conversion functionality to the server, per the Brunson or Alley reference. The Examiner has not provided any evidence to support the assertion of obviousness. If any such evidence exists, Appellant requests that it be provided. MPEP § 2144.03

Claims 2 and 10

Claim 2 depends from claim 16. Claim 10 depends from claim 17. These claims are patentable for at least the same reasons as claim 16 and 17. Further, the claims recite that the apparatuses perform "communication functionalities" or have "communications capability" using stored data. The Examiner's rejection does not mention these terms or synonymous terms or identify any such functionality in the cited references Therefore, the rejections of claims 2 and 10 are clearly erroneous and should be reversed.

Claims 3 and 6

Claims 3 and 6 depend from claim 16 and are patentable for at least the same reasons.

Claims 7 and 9

Claim 7 depends from claim 16. Claim 9 depends from claim 17. These claims are patentable for at least the same reasons as claims 16 and 17. Additionally, the extraction and format conversion recited in the claims would not be obvious because the combination of Bauer/Alley and Brunson is based on impermissible hindsight for the same reasons given in regard to claims 16 and 17—The proposed modification would complicate the system and defeat Bauer's stated objective:

> A goal of the database synchronizer is to minimize the cost of synchronization by reducing communication costs and delays in synchronizing the database data.

(Col. 1, lines 56-59.)

Accordingly, there would be no reason to complicate the system by configuring Bauer system to-for the claimed selective extraction and data conversion, per the Brunson or Alley reference. The Examiner has not provided any evidence to support the assertion of obviousness. If any such evidence exists, Appellant requests that it be provided. MPEP § 2144.03. Otherwise, the rejection stands as clearly erroneous, and should be reversed.

Claim 11

Claim 11 has limitations of determining from "a plurality of corresponding and non-corresponding" mobile terminals, which is a corresponding second mobile terminal for a particular user. These limitations analogous to the set of corresponding apparatus for a particular user, recited in claims 16 and 17. The rejection of claim 11 should be reversed for the same reasons. Further, Bauer alone or in combination with any other cited reference, does not disclose any manner of determining corresponding mobile terminals for a particular user. For at least these reasons, the rejection of claim 11 is clearly erroneous and should be reversed.

Claims 12 and 13

Claims 12 and 13 depend from claim 1. These claims are patentable for at least the same reasons as claim 11. Further, the combination of Bauer with Alley/Brunson is based on impermissible hindsight. Bauer is directed to database management for organizations, and one would not be motivated to modify Bauer to provide the personal information management system features of Alley or Brunson. The Examiner has not provided any evidence to support the assertion of obviousness. If any such evidence exists, Appellant requests that it be provided. MPEP § 2144.03. Otherwise, the rejections stand as clearly erroneous and should be reversed.

Claim 14

Claim 14 depends from claim 11 and is patentable for at least the same reasons.

Claim 15

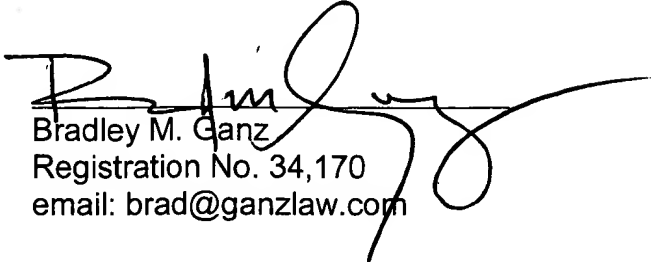Claim 15 depends from claim 11 and is patentable for at least the same reasons. Further, since Bauer is not concerned with management of personal information, it is unclear why there would be motivation to modify Bauer to provide the claimed call initiation feature. Accordingly, there would be no reason to complicate the system by configuring Bauer system in this manner. The Examiner has not provided any evidence to support the assertion of obviousness. If any such evidence exists, Appellant requests that it be provided. MPEP § 2144.03. Otherwise, the rejection stands as clearly erroneous and should be reversed.

In view of the foregoing reasons for distinguishing over the cited references, Applicant has not raised other possible grounds for traversing the rejections, and therefore nothing herein should be deemed as acquiescence in any rejection or waiver of arguments not expressed herein.

For one or more of the reasons set forth above, the Board is respectfully requested to reverse the Examiner's rejection of all claims 2-7 and 9-17 and to confirm patentability thereof.

Respectfully submitted,

Date: April 5, 2004

Bradley M. Ganz
Registration No. 34,170
email: brad@ganzlaw.com

Correspondence to:

Philips Electronics North America Corporation
Intellectual Property & Standards
1109 McKay Drive, Mail Stop SJ 41
San Jose, California 95131
Telephone: (408) 617-7700
Facsimile: (408) 617-4856 .
USPTO Customer Number: 24738